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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: STEIGER et al. Group Art Unit: 1774
Serial No.: 09/867,773 Examiner: B. Shewareged
Filed: May 29, 2001
For: RECORDING SHEETS FOR INK JET PRINTING

Commissioner for Patents Date: October 9, 2002
Washington, D.C. 20231

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RESPONSE TO RESTRICTION REQUIREMENT AND PRELIMINARY AMENDMENT

Sir:

This is responsive to the Restriction Requirement dated September 9, 2002, in the above-identified application.

The Examiner has required that an election of invention be made between the following invention Groups: the recording sheet of Group I (Claims 1-18) and the coating compositions of Group II (Claim 19). Applicants hereby elect the invention of Group I (Claims 1-18) with traverse. The election requirement is traversed for the following reasons:

The Examiner asserts that the inventions of Groups I and II are distinct, as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate-final product is useful to make other than the final product.

The Examiner asserts that the compositions of claim 19 are useful as a wall paint. Applicants respectfully disagree. As defined in independent claim 1, the compositions of the present invention are comprised of at least one binder and a combination of different water insoluble inorganic oxides of aluminum or silicium, or inorganic oxides/hydroxides of aluminum, or aluminum silicates. Moreover, at least one of the oxides, oxides/hydroxides or silicates has at least a certain pore volume and weight percent. These pigmented compositions are coated on a support surface to provide the recording sheets of the invention. The

compositions as defined in independent claim 19 are the same compositions used in the ink jet recording sheets of claims 1-18.

The Manual of Patent Examining Procedure provides that restriction between patentably distinct inventions is proper when (1) the inventions are independent or distinct as claimed, and (2) unrestricted examination would seriously burden the Examiner. See MPEP 803. Neither criterion is met in the present case. It is believed that the fields of search for the recording sheet and composition claims of the invention overlap and that Patent efficiencies will be furthered by unrestricted examination of the application.

For the foregoing reasons, Applicants request that the Examiner reconsider and withdraw the restriction requirement and examine claims 1-19 together.

PRELIMINARY AMENDMENT

IN THE CLAIMS

Please amend claim 17 as follows:

After "atomic number", delete "15" and insert --57--.

This amendment is merely to correct a typographical error. Support for this amendment is found in the specification at page 5, lines 34-37. No new matter has been introduced by this Amendment. It is now believed claims 1-19 are in condition for allowance.

Respectfully submitted,

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CERTIFICATE OF MAILING

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